

REMARKS

In order to expedite prosecution, and as a result of the restriction requirements, Applicants have cancelled claims 1-50, 56-85, and 87-136. Claims 51 and 86 were amended in response to the restriction requirement and claim 53 was amended to correct a minor grammatical error. Applicants submit herewith new claims 137-151.

In the Claims

In order to constructively respond to the restriction requirement placed upon them, Applicants respectfully request the following amendments be made to the claims. First, Applicants request claims 1-50, 56-85, and 87-136 be cancelled without prejudice. Second, Applicants request claim 53 be amended by replacing the word “complexes” with “complex” to correct a minor grammatical error. Third, Applicants request claim 51 and 86 be amended to specify a first protein being BAT3 and a second protein selected from the group consisting of glypcan, LRP2, LRPAP1, transthyretin, and APP, thereby constructively responding to the second restriction requirement. Fourth, Applicants request the addition of new claims 137-151.

Applicants have amended claims 51 and 86 to constructively respond to the restriction requirements placed upon them. Support for amended claims 51 and 86 is found in the as-filed specification at, e.g., paragraphs [0035], [0039], [0083], and [0086]. Applicants submit herewith new claims 137-151. Claims 137-151 finds support in the as-filed specification at e.g., paragraphs [0071-0075] and [0086-0088]. The claims are directed to screening for drug candidates capable of modulating the interaction of BAT3 with a second protein selected from glypcan, LRP2, LRPAP1, transthyretin, or APP. Since new claims 137-151 correspond substantially in scope to the group IX claims which were elected due to the restriction requirement, Applicants respectfully request their entry and consideration on their merits. Applicants submit that the new or amended claims are supported by the specification and no new matter is added to the Application.

Restriction

The restriction requirement divides the claims initially into 33 groups as indicated on pages 2-6 of the office action. A second restriction requirement superimposed upon the first restriction further divides the claims into 13 subgroups as indicated on pages 17-18. Finally, the examiner requests that an election of species be made to one of the four species listed in the claims as detailed on page 19.

Applicants respectfully request that the claims be examined as written. In all groups delineated by the examiner, the inventions stem from the underlying network of protein/protein interactions discovered by the inventor and linked to neurodegenerative disease. Therefore, Applicants respectfully traverse the restriction requirements. However, if the examiner finds Applicants' arguments unpersuasive, Applicants provisionally elect group IX (with claims directed to a method for screening for drug candidates capable of modulating the interaction of a protein complex) and further provisionally elect group A (with claims directed to a first protein being BAT3 and a second protein selected from the group consisting of glypcan, LRP2, LRPAP1, transthyretin, and APP) with traverse.

Applicants respectfully traverse the election of species requirement. 37 C.F.R. §1.146 indicates that if an application contains claims directed to more than a reasonable number of species, the examiner **may** require restriction of the claims to not more than a reasonable number. There are only four species in this particular group. This group is in Markush format and is a classic example of why this format is used. As in most cases, there is no appropriate or true generic language to describe the genus of a Markush group. MPEP 803.02. Even the examiner in requesting selection of species referred to the genus of this Markush groups using the words “[c]urrently, **1** is generic.” (emphasis in original). As members of a Markush group, the Manual of Patent Examining Procedure (MPEP) instructs;

If the members of the Markush group are sufficiently few in number and so closely related that a search & examination of the entire claim can be made without **serious** burden, the examiner **must** examine all the members of the Markush group in the claim on the merits, even though they are directed to independent and distinct inventions. MPEP 803.02 (emphasis added).

It would not be burdensome to examine the application including all listed species. The MPEP reiterates in another section that “[i]f the search and examination of an entire

application can be made without **serious** burden, the examiner must examine it on the merits, even it includes claims to independent or distinct inventions.” MPEP 803 (emphasis added). In this case, it would require very little if any additional effort on the part of the examiner to examine all enumerated species. When searching for the proteins at issue, the examiner will find the fragments of those proteins within the same search.

Finally, if the examiner finds Applicants’ restriction arguments unpersuasive, the only claims under consideration are directed to a method for screening for drug candidates capable of modulating the interaction of a small group of proteins. The request to elect a species was addressed in the context of the claim to the isolated protein complexes. The isolated protein complexes are no longer at issue, and therefore it appears the issue of selection of species may be moot.

For the foregoing reasons, Applicants assert that an election of species is unnecessary and respectfully request the examination of the claims without requiring said election. If Applicants’ arguments are deemed unpersuasive, then Applicants provisionally elect species d (a complex of a fragment of said first protein and a fragment of said second protein) with traverse.

CONCLUSION

In view of the foregoing it is respectfully requested that this application is now in condition for allowance, which action is respectfully requested. The Examiner is invited to telephone the undersigned to expedite allowance of this application.

It is believed that no additional fees are due with this response. However, if an extension of time (and extension fee) or other fees are required, such an extension of time is hereby petitioned for and the Commissioner is authorized to charge any fees or credit any overpayment to Deposit Account No. 50-1627.

Respectfully submitted,



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